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EXAMINER

PLUCINSKI, JAMISUE A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK R. STIFFLER

Appeal 2009-003081
Application 09/891,163
Technology Center 3600

Decided: September 24, 2009

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-16 and 62-68.

We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellant claims a system and method for administering data in a distributed user environment and more particularly to systems and methods for administering international shipping requirements therein. (Spec. 1:5-7).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method operable on a computer for distributing requirements to facilitate international shipping, comprising the steps of:
storing on said computer core requirements applicable to a plurality of countries;
storing on said computer respective country-specific requirements applicable to respective countries;
receiving a request from a requester for requirements for one or more selected countries;
determining if country-specific requirements are stored on said computer for said one or more selected countries;
providing said core requirements to said requester; and providing, if country-specific requirements are stored on said computer for said one or more selected countries, said country-specific requirements to said requester.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Lederer	US 2002/0023109 A1	Feb. 21, 2002
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The following rejections are before us for review.

The Examiner rejected claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 under 35 U.S.C. § 102(e) as being anticipated by Lederer;

The Examiner rejected claims 2, 5, 10 and 14 under 35 U.S.C. § 103(a) as obvious over Lederer.

The Examiner rejected claims 3, 6, 11, 15, 63-64 and 66-67 under 35 U.S.C. § 103 as being unpatentable over Lederer.

ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 under 35 U.S.C. § 102(e) as being anticipated by Lederer on the grounds that Lederer fails to disclose: a. storing on a computer core requirements applicable to a plurality of countries: and b. receiving a request from a requester for requirements for one or more selected countries?

Has Appellant shown that the Examiner erred in rejecting claims 2, 5, 10 and 14 under 35 U.S.C. § 103(a) as obvious over Lederer on the grounds that a person with ordinary skill in the art would understand that a request in Lederer for multiple countries involves no more than a mere multiplicity of steps?

Has Appellant shown that the Examiner erred in rejecting claims 3, 6, 11, 15, 63-64 and 66-67 under 35 U.S.C. § 103 as being unpatentable over Lederer on the grounds that a person with ordinary skill in the art would understand that providing a *matrix chart format* to the requester is a matter of design choice for a person with ordinary skill in the art?

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found that “Lederer also stores country-specific requirements in the GRCS, which the examiner considers to be part of the Lederer system.” (Ans. 6).

2. Lederer discloses that:

[t]he order entry systems (e.g., 102 and 104) generate shipment order records when sales representatives place orders for products (on behalf of customers) using the systems. These records are forwarded to the GRCS 110, which consults its internal databases and tables, and formulates compliance-related data pertaining to the

shipment for dispatch to interested parties. The compliance-related data may specify that the shipment is prohibited. Alternatively, the compliance-related data may identify procedures that should be followed to ensure the legality of the shipment. The regulation source system 112 maintains information regarding regulations adopted by plural regions. The product information generating system 108 maintains information regarding products that may be shipped using the system 100. Information from the regulation source system 112 and the product information generating system 108 may be downloaded to the GRCS's internal data storage, to thereby ensure that the GRCS has up-to-date information for use in making its compliance-related analysis. Each of the above-identified systems will be discussed in further detail below. ([0040])

3. Lederer discloses that “[t]he GRCS 110 may also send a MSDS document in response to an order.” ([0078]).

4. Lederer discloses “[i]f the order is complete, the GRCS 110 determines whether a Material Safety Data Sheet (MSDS) is available for the ordered product...”([0077]).

5. The MSDS sheet identifies the constituent materials used in the product, as well as other data. ([0004],[0005]).

6. The Examiner found that “...it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the request by (*sic*) for multiple countries, since it has been held that a mere multiplicity of parts or steps involves only routine skill in the art.” (Ans. 4).

7. The Examiner found that

[a]t the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the results displayed in a matrix format, because Appellant has not disclosed that displaying the results in a matrix format provides an advantage or solves a stated problem. One of ordinary skill in the art,... (Ans. 5).

ANALYSIS

We affirm the rejection of claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 and reverse the rejection of claims 2, 5, 10 and 14 and 3, 6, 11, 15, 63-64 and 66-67

Claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 rejected under 35 U.S.C § 102(e) as being anticipated by Lederer;

Appellant argues that “Lederer does not store core requirements or country-specific requirements. Rather, Lederer contacts a regulation source system to obtain regulation information.” (Appeal Br. 12). However, the Appellant’s arguments are not persuasive because the Examiner reads the computer as part of the GRCS (FF 1), and the computer of the GRCS “consults its internal databases and tables, and formulates compliance-related data pertaining to the shipment for dispatch to interested parties.”(FF 2).

Appellant further argues that “the present claims recite steps and means for receiving a request from a requester for requirements for one or more selected countries” and Lederer fails to disclose same. (Appeal Br. 12). We disagree with Appellant because shipment order records “are forwarded to the GRCS 110, which consults its internal databases and tables, and formulates compliance-related data

pertaining to the shipment for dispatch to interested parties.” (FF 2). We find that this process in Lederer of forwarding a shipment order to the GRCS for the purpose of formulating compliance-related data pertaining to the shipment is in effect a request for requirements for one or more selected countries as required by the claims. The result of such a request is, according to Lederer, the approval or disapproval of the request, as well as a return to the requester of information via a MSDS document in response to an order (FF 2, 3).

Appellant next argues that receiving the MDDS from the GRCS in Lederer “is not the same as or suggestive of receiving a request for requirements for a specific country.” (Appeal Br. 13). We disagree with Appellant. As discussed above, the order would include shipment data which reasonably must include an address. This address would need to be one country and thus making the request specific to that country.

Claims 2, 5, 10 and 14 rejected under 35 U.S.C. § 103(a) as obvious over Lederer.

Representative claim 2 recites in pertinent part, *wherein said step of receiving a request comprises receiving a request for requirements for a plurality of countries*. The Examiner found that it would have been “obvious to one having ordinary skill in the art at the time the invention was made to have the request by (*sic*) for multiple countries, since it has been held a mere multiplicity of parts or steps involves only routine skill in the art.” (FF 6). We cannot agree with the Examiner since we found *supra* that in Lederer only one country can be listed on a given label at a time in order to assure delivery, thus each request can only pertain

to a single country of designation. We thus do not affirm the rejection of claims 2, 5, 10 and 14.

Claims 3, 6, 11, 15, 63-64 and 66-67 have been rejected under 35 U.S.C. § 103 as being unpatentable over Lederer.

Representative claim 3 recites in pertinent part, *providing said core requirements and said respective country-specific requirements in a matrix chart format.*

The Examiner found that providing a *matrix chart format* is a matter of design choice for a person with ordinary skill in the art. (FF 7). We do not agree with the Examiner. The use of matrix chart format goes to the form of the output to the requester covering both core and respective country-specific requirements, and since we found above a return to the requester includes only a MSDS document, the matrix feature covering both types of data must be supported by some concrete evidence in the record. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). We thus do not affirm the rejection of claims 3, 6, 11, 15, 63-64 and 66-67.

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 under 35 U.S.C. § 102(e) as being anticipated by Lederer.

We conclude the Appellant has shown that the Examiner erred in rejecting claims 2, 5, 10 and 14 under 35 U.S.C. § 103(a) as obvious over Lederer.

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We conclude the Appellant has shown that the Examiner erred in rejecting claims 3, 6, 11, 15, 63-64 and 66-67 under 35 U.S.C. § 103 as being unpatentable over Lederer.

DECISION

The decision of the Examiner to reject claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 is AFFIRMED.

The decision of the Examiner to reject claims 2, 5, 10 and 14; and 3, 6, 11, 15, 63-64 and 66-67 is REVERSED.

AFFIRMED-IN-PART

JRG

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